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09/785,667	02/16/2001	Timothy R. Robinson	KORR116981	5383

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EXAMINER
VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
1732	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/795,667	Applicant(s) ROBINSON et al.
	Examiner M. VARGOT	Group Art Unit 1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-43 is/are pending in the application.

Of the above claim(s) 31-43 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6-8

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-30, drawn to a method of fabricating a thermoset article, classified in class 264, subclass 240.

II. Claims 31-37, drawn to a lens or filter, classified in class 351, subclass 159.

III. Claims 38-41, drawn to a method of using a float glass for molding, classified in class 264, subclass 338.

IV. Claims 42 and 43, drawn to a system for molding a thermoset, classified in class 425, subclass 90.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the products as claimed can be made by other and materially different processes such as those not employing a metal oxide coating on the mold-- siloxanes and PTFE would also have been used as mold coatings to make the instant products.

Inventions I/III, I/IV, II/III, II/IV and III/IV are separate or distinct in that they constitute separate inventions which have different utility in the art and are therefore capable of supporting individual patents. For example, the method of Group I does not require the use of float glass as set forth in Group III claims nor the washer apparatus required in Group IV claims. The product of Group II claims can be made by methods and apparatus other than that recited in Group III and

Group IV claims, respectively. Clearly, the method of Group III can be practiced by apparatus other than that set forth in Group IV, which requires a washer and does not use float glass.

During a telephone conversation with Mr. Kindness on March 20, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31-43 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10, line 2, "or the like" is indefinite in that such renders the metes and bounds of the claim uncertain and the language should be deleted.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turshani et al in view of either of Reiser et al (see col. 26, lines 58-68) or European Patent 307,561.

Turshani et al discloses the basic claimed process of fabricating a thermoset article from a glass mold (col. 9, lines 6-7) by providing a (phosphate ester) ionic release agent within the

thermosetting, polyurethane forming material, providing the resin mixture in the mold and curing same, the primary reference essentially lacking the aspect of the mold having a metal oxide coating thereon. Either of Reiser et al or European -561 disclose the contact of a mold with either a preformed polyurethane sheet (the former) or a polyol/isocyanate mixture which reacts to form a polyurethane (the latter), and each reference teaches coating the mold with a metal or ceramic oxide layer such as tin or titanium or zirconium. Reiser et al discloses that the metal oxide film would be cathode sputtered, such being rather conventional in the art as a physical or chemical vapor deposition. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the method of the primary reference by employing a metal oxide coating on the mold as taught by either secondary reference to facilitate release of the finished article from the mold. It is clear from either secondary reference that a metal oxide coating on the mold facilitates removal of the polyurethane article from the mold. Reiser et al teaches using a glass mold on which the oxide coating is applied. The exact thickness and isoelectric point of the coating layer would have been within the skill level of the art as such are result effective variables readily determined through routine experimentation.

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg.*

Co., 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1-3, 9-17, 22-25 and 27-30 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3, 9-17, 18-21 and 23-26 of copending Application No. 09/769,014. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 4-8, 18-21 and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-8 and 22 of copending Application No. 09/769,014. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims differ from those of the copending application 09/769,014 only in the exact metal used in the metal oxide coating and the employment of sulfites as the release agent, such seen to have been obvious material selections over that claimed in the copending case.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

June 28, 2003

M. Vargot

MATHIEU D. VARGOT
PRIMARY EXAMINER
GROUP 1300

6/28/03